

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM J. HINES

Appeal No. 2001-1398
Application 09/289,171

ON BRIEF

Before CALVERT, FRANKFORT, and MCQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

William J. Hines appeals from the final rejection of claims 1 through 3, 5, 8 through 10 and 21. Claims 6, 7 and 12 through 20, the only other claims pending in the application, stand withdrawn from consideration pursuant to 37 CFR § 1.142(b).

THE INVENTION

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an athletic training shoe insert form constructed to receive the particles of weighted material embedded therein and to hold the particles of weighted material in a fixed position; and the athletic training shoe insert, including the particles of weighted material and the insert form, being designed to be received within an athletic shoe so as to allow a human foot to be placed comfortably in the athletic shoe and to substantially increase the weight of the athletic shoe for training purposes.

THE PRIOR ART

The references relied on by the examiner as evidence of obviousness are:

Shanahan	3,517,928	Jun. 30, 1970
Miyata	5,758,435	Jun. 2, 1998

THE REJECTIONS

Claim 21 stands rejected under 35 U.S.C. § 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter the appellant regards as the invention.

Claims 1 through 3, 5, 8 through 10 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shanahan in view of Miyata.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 12 and 14) and to the examiner's answer (Paper

DISCUSSION

I. Grouping of claims

On page 4 in the main brief, under the "GROUPING OF CLAIMS" heading, the appellant states that "[a]ll of the claims are rejected and have been argued as a single group." Hence, pursuant to 37 CFR § 1.192(c)(7) we shall decide the appeal as to the 35 U.S.C. § 103(a) rejection on the basis of representative claim 1 alone, and claims 2, 3, 5, 8 through 10 and 21 shall stand or fall therewith.

II. The 35 U.S.C. § 112, second paragraph, rejection

The explanation of this rejection asserts that claim 21 is indefinite because

appellant is claiming the embodiment that has "particles of weighted material". However, the last three lines of claim 21, refer to the insert being molded and this would appear to be directed to the embodiment of thin metal strips 11 of relatively soft lead, see [specification] page 10, lines 9-14, and therefore the claim is unclear and indefinite [answer, pages 3 and 4].

The examiner's concern here is unfounded. Although the underlying specification might not expressly state that the

to a human foot" as recited in the last three lines of the claim, the specification as a whole would reasonably convey to the artisan that the recited insert form (particles of weighted material and flexible porous material intermixed) would have this capability. At most, the lack of an express statement to this effect in the specification poses a problem under 37 CFR § 1.75(d)(1) which is easily correctable by amendment to the specification.²

Accordingly, we shall not sustain the standing 35 U.S.C. § 112, second paragraph, rejection of claim 21.

II. The 35 U.S.C. § 103(a) rejection

Shanahan, the examiner's primary reference, discloses a weighted shoe for strengthening the muscles of the leg and/or treating physical defects. The shoe comprises an upper 2, an inner sole 10 and a bottom sole 18. The inner sole 10 supports a flat, weight-receiving member 20 having substantially the same shape and size as the inner sole. Member 20, which is

approximately one-half inch thick and made of a material such as leather, includes a plurality of openings which may be interchangeably filled with plugs 40 of the material (e.g., leather) cut out to form the openings or with similarly shaped weights 44 of lead or other heavy metal to permit the weight of the shoe to be adjusted and varied as desired (see column 3, lines 31 through 51). Although the Shanahan reference teaches that the member 20 is permanently built into the shoe (see column 2, lines 9 through 12 and 27 through 33), it also states that the "weight-receiving member 20 will normally be permanently connected to the (insole) 10" (column 3, lines 52 and 53), thereby suggesting that the member can be removably placed in the shoe.

Miyata also discloses a shoe for strengthening the muscles of the leg. In general, the sole 1 of the shoe comprises an insole 11, a middle sole 10, a rubber layer 14 and an outsole 9 (see Figures 1 and 2). In one embodiment (see Figures 1 through 3), the outsole 9 defines a plurality of weight chambers 6 which

9 can maintain high flexibility while keeping high resilience" (column 3, lines 6 through 8). In a second embodiment (see Figure 7), the outsole 9 includes the metallic grains 7 embedded directly therein. Miyata also discloses that the weights 8 may be embedded in weight chambers 6 formed in the rubber layer 14, and that

the weight chambers 6 may be formed in the cup-shaped insole 11 to embed the weights 8 therein. In this arrangement, since the cup-shaped insole 11 is detachable, the weights 8 are freely detachable from the shoe if it is desired to use the shoe as an ordinary light-weight training shoe (column 4, lines 60 through 65).

In proposing to combine the foregoing references to reject the appealed claims, the examiner concludes that "[i]t would have been obvious to replace the weights of the insert of Shanahan with particles of weighted material enclosed in a flexible material, as taught by Miyata, to provide better flexibility and cushioning characteristics" (answer, page 4).

The appellant's position that this reference combination rests on impermissible hindsight focuses on alleged deficiencies

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invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). Thus, non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references. In re Merck & Co., Inc., 800 F.2d 1091, 1097, 231 USPQ 375, 380 (Fed. Cir. 1986). Notwithstanding any individual deficiencies of the references relative to the claimed subject matter, Miyata's teaching of training shoe weights which are highly resilient and flexible in keeping with the desired resilience and flexibility of such shoes would have furnished the artisan with ample suggestion or motivation to substitute weights of this sort for Shanahan's heavy metal weights in order to provide the Shanahan shoe with increased resilience and flexibility while maintaining Shanahan's capability of adjusting and varying the weight of the shoe.

removable. Thus, this member, with its plugs and/or weights, can be viewed as an "insert" in the sense recited by claim 1.

Moreover, the "insert" limitation also finds response in each of the resilient and flexible weights added to the Shanahan shoe in view of Miyata. Indeed, the limitations in claim 1 are so broad that they are fully met by Miyata alone, specifically the Miyata embodiment wherein weight chambers 6 are formed in removable insole 11 to embed weight chambers 8 therein, such that the weighted insole can be removed from the shoe to attain an ordinary light-weight training shoe.³

In light of the foregoing, the applied references (Shanahan and Miyata) justify the examiner's conclusion that the differences between the subject matter recited in claim 1 and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art at the time the invention was made. Therefore, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claim 1, and claims 2, 3, 5, 8 through 10 and 21 which stand or fall therewith, as being

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SUMMARY

The decision of the examiner:

- a) to reject claim 21 under 35 U.S.C. § 112, second paragraph, is reversed; and
- b) to reject claims 1 through 3, 5, 8 through 10 and 21 under 35 U.S.C. § 103(a) as being unpatentable over Shanahan in view of Miyata is affirmed.

AFFIRMED

IAN A. CALVERT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
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)	APPEALS AND
CHARLES E. FRANKFORT)	
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